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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/027,829

10/19/2001

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2577

28/075 7590 06/19/2009
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EXAMINER

BORISSOV, IGOR N

ART UNIT

PAPER NUMBER

3628

MAIL DATE

DELIVERY MODE

06/19/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRIAN N. TUFTE

Appeal 2009-000309
Application 10/027,829
Technology Center 3600

Decided:¹ June 19, 2009

Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
BIBHU R. MOHANTY, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

The Appellant seeks our review under 35 U.S.C. § 134 of the final rejection of claims 1-30 and 32 which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF THE DECISION

We AFFIRM.

THE INVENTION

The Appellant's claimed invention is directed to methods and systems for increasing the participation of contributors of charities and other non-profits (Spec. 2:5-6). In one illustrative embodiment, the participation of contributors is increased by allowing the contributors to track their donations, or goods and/or services assigned to their donations, to an ultimate destination (Spec. 2:12-15). Claim 1, reproduced below, is representative of the subject matter of appeal.

1. A computer assisted method comprising the steps of:
receiving either directly or indirectly a donation from a contributor;
assigning the donation to a delivery lot;
delivering the delivery lot to one or more people in need;
obtaining the location of the delivery lot at one or more points in time;
and
providing the location of the delivery lot to the contributor at one or more points in time;
wherein a computer processor assists in performing one or more of the receiving, assigning, obtaining and providing steps.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Smith	US 2002/0095306 A1	Jul. 18, 2002
O'Donnell	US 2002/0013739 A1	Jan. 31, 2002
Price	US 2002/0120539 A1	Aug. 29, 2002
Burke	US 6,876,971 B1	Apr. 5, 2005

Make a Difference Day Honorees,
<http://www.usaweekend.com/diffday/honorees/1999/> (last visited Nov. 13, 2005) (hereinafter “Make a Difference Day Awards”).

Episcopal Relief and Development - Projects for Hope,
<http://web.archive.org/web/20001017140838/www.er-d.org/projectsforhope.htm> (last visited Nov. 16, 2005) (hereinafter “Projects for Hope”).

The following rejections are before us for review:

1. Claims 10 and 20-23 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.
2. Claims 1-26 and 28 are rejected under 35 U.S.C. § 103(a) as unpatentable over Projects for Hope and Smith.
3. Claim 27 is rejected under 35 U.S.C. § 103(a) as unpatentable over Projects for Hope, Smith, and Make a Difference Day Honorees.
4. Claim 29 is rejected under 35 U.S.C. § 103(a) as unpatentable over Projects for Hope, Smith, and O'Donnell.
5. Claim 30 is rejected under 35 U.S.C. § 103(a) as unpatentable over Projects for Hope, Smith, and Burke.
6. Claim 32 is rejected under 35 U.S.C. § 103(a) as unpatentable over Projects for Hope, Price, and Smith.

THE ISSUES

At issue is whether the Appellant has shown that the Examiner erred in making the aforementioned rejections.

With regards to claims 10 and 20-23 as rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement this issue turns on whether the Specification provides support for a “cash equivalent” as recited in claim 10 and for the recitation “wherein the two or more donations are not initially designated as corresponding to any particular delivery lot” as recited in claims 20-23.

With regards to claims 1-28, 30, and 32 this issue turns on whether the combination of Projects for Hope and Smith disclose or suggest the claim limitations argued by the Appellant and if the combination of the references would have been obvious to one of ordinary skill in the art.

With regards to claim 29 this issue turns on whether the combination of Projects for Hope, Smith, and O'Donnell disclose or suggest the claim limitations argued by the Appellant and if the combination of the references would have been obvious to one of ordinary skill in the art.

FINDINGS OF FACT

We find the following enumerated findings of fact (FF) are supported at least by a preponderance of the evidence:²

FF1. Projects for Hope disclose a list of charitable projects available for funding support online (Page 1).

² See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

FF2. Projects for Hope discloses a project number, location of the project, project description, and what the donation amount will be used to fund. For example, Project Number PH0001 is in Mexico, will be used to buy supplies for a facility serving children in need, and \$440 will help purchase furniture and supplies (Page 10).

FF3. Projects for Hope discloses that donations may be used in “the area of greatest need” and thus give contributions which are unassigned (Page 7).

FF4. Smith discloses a mail piece tracing and tracking system for linking data objects and physical objects (Title and Abstract).

FF5. Smith discloses that information is provided to the user relating to the delivery of packages, catalogs or other mail pieces sent to or by the user through various catalog companies, delivery services, and/or the postal service. The user is provided the updated information through a personal web page site. [0009].

FF6. O'Donnell discloses an apparatus and method for providing anonymous shipping services (Title, [0002])

FF7. O'Donnell discloses that the apparatus for shipping may include anonymous donations and anonymous chat rooms [0146].

FF8. The Specification discloses that donations may be received a “VISA card number” or “by cash or check” (Page 7:6-13).

FF9. The Specification states that: “The donations that have been accumulated to meet the resource request may then be updated to include a pointer or other reference to the assigned delivery lot” (Page 3:11-13).

PRINCIPLES OF LAW

Principles of Law Relating to Obviousness

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 550 U.S. at 407 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *id.* at 415-16, and discussed circumstances in which a patent might be determined to be obvious. In particular, the Supreme Court emphasized that “the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*, 11 How. 248.” *KSR*, 550 U.S. at 415, (citing *Graham*, 383 U.S. at 12), and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* at 416. The Court also stated “[i]f a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability.” *Id.* at 417. The operative question in this “functional approach” is thus “whether the

improvement is more than the predictable use of prior art elements according to their established functions.” *Id.*

The Court noted that “[t]o facilitate review, this analysis should be made explicit.” *Id.* at 418 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”). However, “the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.*

ANALYSIS

Claim Rejections under 35 U.S.C. § 112, first paragraph

The Appellant argues that the rejection of claims 10 and 20-23 under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement because the claims contain subject matter which was not described in the Specification in such a way to reasonably convey to one skilled in the art that the inventor, at the time the application was filed had possession of the claimed invention is improper. The Appellant argues with regard to claim 10 that it is well known that there are a variety of alternatives to paying cash and that the Specification refers to cash equivalents such as checks and credit card transfers (Br. 11, Reply Br. 3-4). The Appellant argues with regard to claim 20 that the Specification provides support for the limitation “wherein the two or more donations are not initially designated as corresponding to any particular delivery lot” (Br. 12, Reply Br. 4-5).

The Examiner has determined that claims 10 and 20-23 are properly rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. Specifically the Examiner has found that the Specification does not provide any indication of a “cash equivalent” as recited in claim 10. The Examiner has also found that the Specification provides no support for the recitation in claim 20 for “wherein the two or more donations are not initially designated as corresponding to any particular delivery lot.”

We agree with the Appellant. To satisfy the written description requirement, the disclosure must convey with reasonable clarity to skilled artisans that the Appellant was in possession of the claimed invention as of the filing date. *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991). “It is not necessary that the claimed subject matter be described identically, but the disclosure originally filed must convey to those skilled in the art that applicant had invented the subject matter later claimed.” *In re Wilder*, 736 F.2d 1516, 1520 (Fed. Cir. 1984) (citing *In re Kaslow*, 707 F.2d 1366, 1375 (Fed. Cir. 1983)).

Here with regard to claim 10, the Specification discloses that donations may be received a “VISA card number” or “by cash or check” (FF8). One of ordinary skill in the art would readily have inferred that a credit card or check would be a “cash equivalent” even though not described identically in the Specification and that the applicant was in possession of the claimed invention as of the filing date.

With regard to claim 20 the Specification states that: “The donations that have been accumulated to meet the resource request may then be updated to include a pointer or other reference to the assigned delivery lot” (FF9). Since the Specification states that the donations may not be

immediately assigned a delivery lot one of ordinary skill in the art would readily have inferred this to show “wherein the two or more donations are not initially designated as corresponding to any particular delivery lot” and that the Applicant was in possession of the claimed invention as of the filing date.

For these above reasons the rejection of claims 10 and 20, and dependent claims 21-23 which depend from claim 20, under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement is not sustained.

Claims 1-19, 24-28 and 30

The Appellant argues that the rejection of claim 1 under 35 U.S.C. § 103(a) as unpatentable over Projects for Hope and Smith is improper. The Appellant argues that in Projects for Hope, the sender of the goods is clearly the Projects for Hope organization, and not the contributor, whose only role is making a donation via the Projects for Hope website (Br. 14, Reply Br. 6-7). The Appellant also argues that Smith does not disclose or suggest providing the location of the delivery lot to the contributor at one or more points in time (Br. 15).

The Examiner has determined that Projects for Hope teaches a website where contributors can donate goods or services to organizations and that Smith teaches a method for tracking the items (Ans. 4-5). The Examiner has also determined that the contributor in the Projects for Hope reference equates to the “sender” and that the shipping service provider corresponds to the charitable organization.

We agree with the Examiner. Projects for Hope discloses a list of projects available for funding support online (FF1). Projects for Hope

discloses with each charitable project a project number, location of the project, project description, and what the donation amount will be used to fund (FF2). Smith discloses a mail piece tracing and tracking system for linking data objects and physical objects (FF4). Smith discloses that information is provided to the user relating to the delivery of packages, catalogs or other mail pieces sent to or by the user through various catalog companies, delivery services, and/or the postal service (FF5). The modification of the online donation system of the Projects of Hope to track items which are being shipped as disclosed by Smith is considered an obvious and predictable use of prior art elements according to their established functions for the benefit of tracking that the donation was actually used. In the Projects of Hope disclosure the person making the contribution online clearly can be considered the “sender” since without them no such donation would be imitated and taking place. Regardless, one of ordinary skill in the art would see the obvious and predictable advantage in allowing the person making the donation to track the shipment of the items of their donation to see that the items were actually shipped. For these reasons the rejection of claim 1 under 35 U.S.C. § 103(a) as unpatentable over Projects for Hope and Smith is sustained. The Appellant has not argued claims 2-19, 24-26, and 28 separately and the rejection of these claims is rejected for these same reasons.

The Appellant’s arguments for claim 27 are the same as addressed above and for the same reasons given above the rejection of claim 27 under 35 U.S.C. § 103(a) as unpatentable over Projects for Hope, Smith, and Make a Difference Day Honorees is sustained.

The Appellant's arguments for claim 30 are the same as addressed above and for the same reasons given above the rejection of claim 30 under 35 U.S.C. § 103(a) as unpatentable over Projects for Hope, Smith and Burke is sustained.

Claims 20-23 and 32

The Appellants argue that the rejection of claim 20 under 35 U.S.C. § 103(a) as unpatentable over Projects for Hope and Smith is improper because the references fail to disclose "wherein the two or more donations are not initially designated as corresponding to any part corresponding lot" or "each contributor receiving the location of the delivery lot(s) that corresponds to the contributor's donation(s)" (Br. 18-19).

In contrast the Examiner has determined that Projects for Hope does disclose that donations may be used in "the area of greatest need" and thus give contributions which are unassigned (Ans. 17).

We agree with the Examiner. Projects for Hope does disclose that donations may be used in "the area of greatest need" and thus give contributions which are unassigned (FF3) and as such these donations would not be initially designated as corresponding to any part corresponding lot. Once Projects of Hope assigned these donations to the area of greatest need the modification of the system to track items which are being shipped as disclosed by Smith is considered an obvious and predictable use of prior art elements according to their established functions for the benefit of tracking that the donation was actually used. For these reasons the rejection of claim 20 under 35 U.S.C. § 103(a) as unpatentable over Projects for Hope; and Smith is sustained. The Appellant has not argued claims 21-23 separately and the rejection of these claims is rejected for these same reasons.

The Appellant's arguments for claim 32 are same as addressed above and for the same reasons given *supra* the rejection of claim 32 under 35 U.S.C. § 103(a) as unpatentable over Projects for Hope, Price, and Smith is sustained.

Claim 29

The Appellant argues that the rejection of claim 29 under 35 U.S.C. § 103(a) as unpatentable over Projects for Hope, Smith, and O'Donnell do not teach to providing a chat room so that that the contributors that provided donations to a common delivery lot can communicate with each other (Br. 20).

In contrast the Examiner has determined that O'Donnell does disclose the facilitations of chat rooms for anonymous donations (Ans. 17) and that the combination of the references would have been obvious.

We agree with the Examiner. Projects for Hope discloses with each online charitable project a project number, location of the project, project description, and what the donation amount will be used to fund (FF2). Smith discloses a mail piece tracing and tracking system for linking data objects and physical objects (FF4). O'Donnell discloses an apparatus for shipping including anonymous donations and anonymous chat rooms (FF7). The modification of the online donation system of Projects of Hope to track items which are being shipped as disclosed by Smith and to include a chat room to allow the anonymous donors to communicate as taught by O'Donnell is considered an obvious and predictable use of prior art elements according to their established functions for the benefit of tracking that the donation was actually used and to allow donors to communicate. O'Donnell has disclosed an apparatus for shipping including anonymous donations and anonymous chat rooms and the extension of this teaching to the disclosures

of Projects of Hope and Smith to provide a way for donors to communicate with each other would have been a predictable benefit. For these reasons the rejection of claim 29 under 35 U.S.C. § 103(a) as unpatentable over Projects for Hope, Smith, and O'Donnell is sustained.

CONCLUSIONS OF LAW

We conclude that Appellant has shown that the Examiner erred in rejecting claims 10 and 20-23 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

We conclude that Appellant has failed to show that the Examiner erred in rejecting claims 1-26 and 28 under 35 U.S.C. § 103(a) as unpatentable over Projects for Hope and Smith.

We conclude that Appellant has failed to show that the Examiner erred in rejecting claim 27 under 35 U.S.C. § 103(a) as unpatentable over Projects for Hope, Smith, and Make a Difference Day Honorees.

We conclude that Appellant has failed to show that the Examiner erred in rejecting claim 29 under 35 U.S.C. § 103(a) as unpatentable over Projects for Hope, Smith, and O'Donnell.

We conclude that Appellant has failed to show that the Examiner erred in rejecting claim 30 under 35 U.S.C. § 103(a) as unpatentable over Projects for Hope, Smith, and Burke.

We conclude that Appellant has failed to show that the Examiner erred in rejecting claim 32 under 35 U.S.C. § 103(a) as unpatentable over Projects for Hope, Price, and Smith.

DECISION

The Examiner's rejection of claims 1-30 and 32 is sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

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